



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,278	09/19/2003	Stanley M. Josephson	34823-400200	2277

27717 7590 03/09/2005

SEYFARTH SHAW
55 EAST MONROE STREET
SUITE 4200
CHICAGO, IL 60603-5803

EXAMINER

PATEL, SHEFALI D

ART UNIT PAPER NUMBER

2621

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/605,278	Applicant(s) JOSEPHSON, STANLEY M.	
	Examiner Shefali D Patel	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>8/30/04</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 3-8 drawn to a method of processing payment material, classified in class 382, subclass 218.
 - II. Claim 22, drawn to a method of determining if a customer has requested to opt out of truncation of a negotiable document, classified in class 705, subclass 40.
 - III. Claim 23, drawn to a payment document used for submission with a customer's monetary document, classified in class 283, subclass 59.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions **I and II** are related as subcombinations disclosed as **usable together** in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as determining if a customer has requested to opt out of truncation of a negotiable document providing on a payment document, that is to be submitted with the negotiable document, an accounts receivable conversion truncation indicator which does not require processing payment material to determine if the payment filed matches the input field of the electronic template for the biller as recited in the invention I. See MPEP § 806.05(d).
3. Inventions **I and III** are related as subcombinations disclosed as **usable together** in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as a payment document used for submission with a customer's monetary document having an accounts receivable conversion truncation indicator to signify the customer's desire of participation in an accounts receivable conversion truncation process which does

Art Unit: 2621

not require processing payment material to determine if the payment filed matches the input field of the electronic template for the biller as recited in invention I. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Newly submitted claims **22-23** are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 22 is directed to a method of determining if a customer has requested to opt out of truncation of a negotiable document and therefore belongs in class 705 whereas claim 23 is directed to a payment document used for submission with a customer's monetary document and belongs to class 283.

Since applicant has received an action on the merits for the **originally presented invention**, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. NOTE: Cancellation of claims 22-23 will be expected in case this application is put in a condition for allowance.

Response to Amendment

1. The amendment was received on November 3, 2004.
2. Substance of the interview on page 4 along with the amendment has been accepted and the examiner is including a copy of the Interview Summary held on August 30, 2004.
3. In results of the interview, the objection made to claims 1-20 in an Office Action mailed on August 26, 2004 has been withdrawn.

Art Unit: 2621

4. The applicant repeatedly mentions on page 3 (claims) and on very bottom of the page 5 (remarks) that claims 9-21 have been canceled. For the record, the examiner would like to add that original claim 21 never existed. There were only twenty (20) original claims filed on September 19, 2004.
5. Claims 2 and 9-20 have been cancelled.
6. Claims 1, 3-8, and 22-23 are pending.

Response to Arguments

7. Applicant's arguments with respect to claims 1-20 on pages 5-6 of the remarks filed on November 3, 2004 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

8. Claim 1 is objected to because of the following informalities: claim 1 line 7 on page 2 states "parsing the digital image for ~~the payment information~~ the biller identification...". The word "the" occurs twice before and after the amendment. Appropriate correction is required.
9. Claims 8 and 22-23 are objected to because of the following informalities: claim 8 line 2, claim 22 lines 4 and 6, claim 23 lines 2-3 recites "an accounts." Please be clear on whether the claim means to disclose one or two accounts. Appropriate correction is required.
10. The following quotations of 37 CFR § 1.75(a) is the basis of objection:
 - (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.
11. Claim 8 is objected to under 37 CFR § 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

The examiner noticed that the specification refers to a "Receivable Conversion System (ARC) truncation indicator." However, it is unclear what really is a "receivable conversion truncation indication" (see specification paragraph 35 and paragraph 54 in conjunction with Figure 8). It is not clear what is

Art Unit: 2621

meant by "receivable conversion truncation indication" as recited in claim 8. The specification does not describe in detail the limitations recited at lines 2-3 of claim 8. Applicant is invited to point to the section of the specification that provides support for this limitation, or to amend the specification to provide such support (i.e., without adding new matter).

The following will be assumed for examination purposes: "...payment material further includes an accounts [receivable conversion truncation] indication"

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 3, 4, and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kolling et al. (hereinafter, "Kolling") (US 5,963,925).

With regard to **claim 1** Kolling discloses a method of processing payment material (ESP 100 and 200, Figures 2-3, col. 7 lines 26-27, col. 8 lines 37-39), comprising: providing a database (UBF 300, col. 14 lines 1-7 and 39-46) having an electronic template (template 212, col. 8 lines 5-59) having a biller identifier (biller id at 304, col. 14 lines 47-54) and a validating record field (validating field 218, col. 8 lines 59-65, col. 14 lines 56-64); providing on the payment material (Figure 10) a biller identification (element 841 and 846) and a payment field (element 844 on col. 30 lines 44-50); scanning the payment material to create a digital image (the ESP system 200); parsing the digital image for the biller identification and the payment field (parsing at col. 18 lines 27-40 also seen in Figure 5); matching the biller identification with the biller identifier (biller information is matched and identified with the biller identifier at col. 14 lines 40-64); and determining if the payment field matches the input field of the

Art Unit: 2621

electronic template for the biller (payment field matches the input field of the template when a confirmation screen is outputted to the consumer at col. 32 lines 33-46, Figure 16).

With regard to **claim 3** Kolling discloses the biller identification is selected from a group consisting essentially of a mailing address of the biller, icons, logos, telephone numbers, symbols and watermarks (biller identification such as, company name, address, telephone numbers, mailing information, and other descriptive information at col. 14 lines 50-54, also seen in Figure 10).

With regard to **claim 4** Kolling discloses the biller identification including machine- readable font (the document includes machine-readable font so that the element 210 in Figure 2 is able to transform a hard copy of the document into a digital form by PDF reader or OCR as disclosed at col. 10 lines 7-21).

With regard to **claim 7** Kolling discloses the machine readable font including an OCR font at col. 10 lines 7-21.

With regard to **claim 8** Kolling discloses the payment material further include an accounts indication at col. 14 line 58 and also seen at element 842 in Figure 10.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. (hereinafter, "Kolling") (US 5,963,925) in view of Brooks et al. (US 5,754,673) (hereinafter, ("Brooks")).

With regard to **claim 5** Kolling discloses method of claim 4 as disclosed above and the arguments are not repeated herein, but are incorporated by reference. Kolling does not expressly disclose the machine readable font including magnetic ink character recognition (MICR) font. Brooks discloses a document that has MICR font at col. 3 lines 26-41. Kolling and Brooks are combinable because they are

Art Unit: 2621

from the same field of endeavor, i.e., image processing for financial documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Brooks with Kolling. The motivation for doing so is to read machine-readable information printed on the document by the MICR reader 32 as suggested by Brooks at col. 3 lines 50-55. Therefore, it would have been obvious to combine Brooks with Kolling to obtain the invention as specified in claim 5.

With regard to claim 6 Brooks discloses the machine readable font including a bar code font at col. 12 lines 5-12.

With regard to claim 7 Brooks discloses machine readable font including an OCR font at col. 3 line 51 and col. 6 lines 1-22.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,609,200 – method and system for processing electronic documents.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2621


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D Patel whose telephone number is 703-306-4182. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M Mehta can be reached on (703) 308-5246. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shefali D Patel
Examiner
Art Unit 2621

March 1, 2005


BRIAN WERNER
PRIMARY EXAMINER